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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/807,227 | 03/22/2004 | Kinam Park | 368-011C | 1689 |

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| EXAMINER | |
|---|---|
| COONEY, JOHN M | |
| ART UNIT | PAPER NUMBER |
| 1711 | |

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/807,227 | PARK ET AL. | |
| | Examiner | Art Unit | |
| | John m. Cooney | 1711 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *01 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's arguments filed 12-1-05 have been fully considered but they are not persuasive.

Any rejection not set forth herein is hereby withdrawn:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-40 are rejected under 35 U.S.C. 102(a) as being anticipated by DE-195 40 951 (corresponding to USPAT 6,136,873)(Hereon referred to as HAHNLE et al.).

HAHNLE et al. disclose preparations of superabsorbent polymeric hydrogel composite materials prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other additives and agents reading on the materials of applicants' claims (See HAHNLE et al. in its entirety). [ – Note also – the following cites from USPAT 6,136,873 {for informational purposes only} pertaining to English language recitations of the later US equivalent – abstract, column 1 lines 12-16, column 2 line 24 et seq., column 3, column

5 line 26 et seq., column 6 lines 1-9, column 8 lines 49 et seq., column 9 lines 1-30, column 10-13, column 14 lines 1-6, and the examples - ].

As the record currently stands, applicants' reference to the materials of their claims as being an interpenetrating network is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of HAHNLE et al. and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of an interpenetrating network to the degree defined by applicants' claims is held to be inherent to the teachings of HAHNLE et al.

Regarding applicants' claim of priority, it is noted that if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 USC 112 in the parent non-provisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application {See M.P.E.P. 211.11 VI }. Such is the case here. The 5,750,585 patent does not adequately disclose the broadly or specifically defined disintegrant materials of the instant claims. Additionally, it is not seen that applicants' method claims which set forth the generically defined term "disintegrant" are adequately disclosed and/or envisioned by the 5,750,585 patents' suggestive disclosure of fillers for strengthening and/or absorbance purposes (see column 6 lines 40-51 of the 5,750,585 patent). This disclosure is not seen to adequately disclose the invention of the instant claims.

Applicants' arguments have been considered, but rejection is maintained as now set forth under 35 USC 102(a) for the reasons set forth above. Applicants' arguments relate to differences not supported by the limitations set forth in the claims and do not, therefore, serve to demonstrate distinction of their invention as claimed.

Claims 1-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Phan et al.(5,506,035).

Van Phan et al. disclose preparations of superabsorbent crosslinked composite polymer network materials which are insoluble in water but swell to an equilibrium size in the presence of excess water {hydrogel} and are prepared by combining under polymerization conditions ethylenically-unsaturated monomers, multi-olefinic crosslinking materials, and other additives and agents reading on the materials of applicants' claims (See the abstract, column 6 line 34 et seq., column 7, column 8 lines 1-53, and column 10 lines 35-60, as well as, the entire document).

As the record currently stands, applicants' reference to the materials of their claims as being an interpenetrating network is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of Van Phan et al. and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of an interpenetrating network to the degree defined by applicants' claims is held to be inherent to the teachings of Van Phan et al. Further, the cellulosic disintegrant materials and broader group of disintegrant

materials of applicants' claims are not seen to differ from the cellulosic materials and larger group of viscosity control agents of Van Phan et al. in a patentable sense.

Applicants' arguments have been considered, but rejection is maintained for the reasons set forth above. Applicants' claims are not limited to the disintegrant materials discussed in their reply. Further, the materials indicated in the rejection above are maintained to disclose included materials which read on the disintegrant materials as defined by the claims.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8-16, 18-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,750,585. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the 5,750,585 patent claims disclose crosslinked hydrogel matrix materials as claimed by applicants but differ in that disintegrants are not particularly recited. However, looking to 5,750,585's disclosure for definition of practicing the procedures of the claims identifies the inclusive embodiment of fillers (see column 6 lines 40-51) which include materials meeting the definition of the broad term "disintegrant" and disintegrant component (v.) of applicants' claims. Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the absorbent materials of 5,750,585's disclosure for the purpose of imparting their absorbent effect in the preparations of the claims of 5,750,585 in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The required showing of new or unexpected results has not been made and/or is not seen.

Additionally, as the record currently stands, it is seen that the above rejection is properly set forth along with the above denial of 5,750,585's effective filing date for all of the claims, because, although adequate disclosure of the generically defined "disintegrant" materials for the reasons set forth above is lacking , suggestion for obviousness for the reasons set forth above is seen to be evident.

However, if the record establishes that adequate support for the broad term "disintegrant" is provided for by this disclosure, then the rejection of claims 33-40 over the HAHNLE et al. reference will be withdrawn and the above Double Patenting rejection maintained.

Applicants' arguments have been considered, but rejection is maintained for the reasons set forth above. It is maintained that the supporting disclosure of 5,750,585 is properly looked to for definition of practicing the procedures of the claims, and rejection is not negated by applicants' assertions that such is not the case. Additionally, applicants' arguments pertaining to expiration dated of patents are not sufficient to negate the requirement for filing of a terminal disclaimer as one means of overcoming the above rejection.

Claims 1-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,960,617. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 6,960,617 disclose crosslinked hydrogel matrix materials as claimed by applicants that employ strengthening materials that overlap with the disintegrant materials in a manner which would have been obvious to one having ordinary skill in the art.

Applicants' arguments have been considered, but rejection is maintained for the reasons as now set forth in the non-provisional rejection set forth above. Applicants' arguments pertaining to expiration dated of patents are not sufficient to negate the requirement for filing of a terminal disclaimer as one means of overcoming the above rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700